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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRAULIO A. POLANCO,  
CHRISTOPHER DALE FENWICK,  
DARRYL FRANKLIN CLARK,  
BRYAN DAVID HAYNES,  
KURTIS LEE BROWN,  
CHAD MICHAEL FREESE and  
ERIC SCOTT KEPNER

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Appeal 2007-3380  
Application 10/749,805  
Technology Center 1700

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Decided: December 27, 2007

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Before BRADLEY R. GARRIS, CHUNG K. PAK, and THOMAS A.  
WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the  
Primary Examiner's final rejection of claims 1-22, 24-38, 40-46, 48, and 49,

which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to nonwoven webs of substantially continuous A/B bicomponent crimped fibers having a measured formation index value for one or both of a top surface of the web and a wire (bottom) surface of the web, where the webs are produced through use of an unheated fiber draw unit (FDU) (Br. 3).<sup>1</sup> Independent claim 1 and dependent claim 2 are illustrative of the invention and a copy of these claims is reproduced below:

1. A nonwoven material comprising:
  - a) a web of substantially continuous A/B bicomponent crimped fibers,
  - b) the web having a percentage difference between a formation index of a top side of the web and a formation index of a wire side of the web of less than about 11%.
2. The nonwoven material according to Claim 1 wherein:
  - a) the web has a formation index averaging above about 37.6 on the top side of the web when the web has a bulk to about 0.1 inches in the Z axis, or wherein
  - b) the web has a formation index averaging above about 32.03 on the top side of the web when the web has a bulk of over about 0.1 inches in the Z axis.

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<sup>1</sup> We refer to and cite from the “**SECOND SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37**” dated Aug. 28, 2006.

The Examiner has relied upon the following prior art references as evidence of unpatentability:

|         |           |               |
|---------|-----------|---------------|
| Pike    | 5,382,400 | Jan. 17, 1995 |
| Suddeth | 5,770,531 | Jun. 23, 1998 |

#### ISSUES ON APPEAL

Claims 2-9, 20-22, 24-38, 40-46, 48, and 49 stand rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the enablement requirement (Ans. 3).

Claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Pike (Ans. 4).

Claims 16-18 and 31-33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pike in view of Suddeth (Ans. 5).<sup>2</sup>

Appellants contend that there is no legal basis for the Examiner's requirement of a correlation or "discernable trend" for the properties or parameters of the web under the statute (App. Br. 5; Reply Br. 3).

Appellants contend that the formation index and bulk are measurable properties, correlating with the basis weight, and all that is needed for enablement is measurement of these properties, which is well within the ordinary skill in this art (App. Br. 6; Reply Br. 2-3; Supp. Reply Br. 2<sup>3</sup>).

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<sup>2</sup> The Examiner has stated that the prior rejections under 35 U.S.C. § 112, ¶2, and for obviousness-type double patenting have been withdrawn (Ans. 2: ¶(6)).

<sup>3</sup> We refer to and cite from the "**REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER**" dated Mar. 9, 2007.

Appellants further contend that the Examiner has not provided sufficient factual findings with respect to the scope of the claims, undue experimentation, or the ordinary level of skill in this art, to establish a prima facie case of lack of enablement (App. Br. 6).

Appellants contend that the Examiner has not provided sufficient factual findings from Pike to establish a prima facie case, since Pike discloses a hot FDU process while the claimed nonwoven material is produced by a cold FDU process (App. Br. 8). Appellants contend that their Specification distinguishes between cold and hot FDU processes (App. Br. 8; Reply Br. 6).

Appellants contend that a correct interpretation of their data requires the formation index to be determined from an average of 20 samples, and the Examiner departs from this test procedure and views the measurements in isolation in applying Pike against the claims (Reply Br. 6; Supp. Reply Br. 3).

The Examiner contends that the Specification does not teach a person of ordinary skill in the art how the formation index correlates with the bulk or basis weight of the web, and there is no discernible trend in these values that would allow the artisan to arrive at these values and reproduce the invention (Ans. 3-4 and 6; Supp. Ans. 2).

The Examiner agree with Appellants that Pike produces nonwoven material by a hot FDU process but contends that Appellants' Specification acknowledges that hot FDU processes produce nonwoven materials that

possess the claimed properties at least for one sample (Ans. 7-9; Supp. Ans. 3).

Accordingly, we determine the following issues presented from the record in this appeal: (1) Has the Examiner met the initial burden of establishing that the claimed nonwoven materials could not be reproduced in view of the disclosure in the Specification; and (2) Has the Examiner established that the disclosure of Pike, as exemplified in the data from Appellants' Specification, meets every limitation of claim 1 on appeal as properly construed?<sup>4</sup>

We determine that the Examiner has not established a prima facie case of lack of enabling disclosure for the reasons stated in the Briefs as well as those reasons set forth below. Therefore, we REVERSE the rejection based on § 112, first paragraph. However, we determine that the Examiner has established a prima facie case of anticipation/obviousness in view of Pike and the Specification data for the reasons stated in the Answers, as well as those reasons set forth below. We note that Appellants have not contested the application of Suddeth against several dependent claims (App. Br. 9), and therefore we adopt the Examiner's factual findings and conclusion of law with regard to this rejection (Ans. 5). Therefore, we AFFIRM the prior

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<sup>4</sup> As correctly noted by the Examiner (Ans. 9), with regard to the rejection over Pike, Appellants do not present arguments with specificity to any particular claim (*see* the Briefs in their entirety). Therefore we select claim 1, the broadest independent claim, from the grouping of claims and decide this ground of rejection on the basis of this claim alone. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

art rejections based on § 102(b)/§ 103(a) and § 103(a). Accordingly, the decision of the Examiner to reject the claims on appeal is AFFIRMED.

### OPINION

#### A. The Rejection under § 112, ¶ 1

The initial burden of proof rests with the Examiner in establishing, by technical reasoning or other evidence, that Appellants' Specification lacks enabling disclosure to make or use the invention as claimed. *See In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993); *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971). Whether making and using the invention would have required undue experimentation, and thus whether the disclosure is enabling, is a legal conclusion based upon several underlying factual inquiries. *See In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1988). It is not necessary that the Examiner review all of the *Wands* factors<sup>5</sup> to find a disclosure non-enabling, but what is relevant depends on the facts. *See Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1213 (Fed. Cir. 1991).

On the record in this appeal, the only factual findings from the Examiner are that “[t]here is no discernable trend between these values [the data disclosed in the Specification]” (Ans. 4; Supp. Ans. 2) and that the Specification does not teach a person of ordinary skill in the art how the formation index “correlates” with the bulk or the basis weight of the web (Ans. 3). However, as correctly argued by Appellants, there is no requirement in the statute for a “discernable trend” in the data, nor that the

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<sup>5</sup> *In re Wands*, 858 F.2d at 735-37.

measured data “correlates” with each other (App. Br. 5; Reply Br. 3). The Examiner has not established, or even alleged, that Appellants’ Specification does not disclose a method of preparing the claimed nonwoven materials (e.g., *see* Fig. 1 and text at Specification 10-11). As also correctly argued by Appellants (App. Br. 6; Reply Br. 2), and not contested by the Examiner, all of the data in question are the result of physical measurements known in the art (i.e., formation index, bulk, basis weight, and fiber denier; *see* the Specification 16-21). Therefore, we determine that the Examiner has not met the initial burden of proof by advancing reasons or evidence why one of ordinary skill in the art would not be able to make or use the invention as claimed. We agree with Appellants that one of ordinary skill in this art would have recognized that bulk, basis weight, and formation index are generally related, and also depend on other properties such as fiber density, type of material, and fiber size (Reply Br. 2-3). Although some experimentation might be necessary to reproduce Appellants’ results, the Examiner has not established that this would require undue, rather than routine, experimentation.

For the foregoing reasons and those stated in the Briefs, we cannot sustain the Examiner’s rejection of claims 2-9, 20-22, 24-38, 40-46, 48, and 49 under the first paragraph of § 112 for lack of enabling disclosure.

B. The Rejection under § 102(b)/§ 103(a) over Pike

Implicit in our review of the Examiner’s anticipation/obviousness analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v.*

*Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997). As shown above by the contentions of the Appellants and the Examiner, the only “contested limitation” is whether claim 1 on appeal is limited to formation indices based on one or more samples tested or is the claim limited to an “average” formation index of twenty (20) samples (Rely Br. 6; Supp. Reply Br. 2-3; Ans. 7-9; Supp. Ans. 3).

During prosecution before the Examiner, the Examiner must apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account any definitions or enlightenment afforded by the original specification disclosure. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “[P]articular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.” *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1054 (Fed. Cir. 1994). The PTO should only limit the claim based on an express disclaimer of a broader definition. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Applying these legal principles to the facts of this appeal, we determine that the scope of claim 1 on appeal includes formation index values from any number of samples and does not require a formation index “averaging” twenty (20) samples. The plain language recited in claim 1 on appeal does not require “averaging” or that the formation index is an average value of any specific number of samples, but merely calls for “a formation index” of the top side of the web and “a formation index” of the bottom

(wire) side of the web. Appellants' Specification discloses that a formation index value is based on light transmission/reflectance of the web and measures sheet uniformity (3:14-17). Appellants define "Formation index" as the M/K test formation index value, which is the quotient of the number of pixels in the modal weight class of pixel light divided by the total number of weight classes observed (Specification 8:12-19). The procedure for measuring a "Formation index" is detailed by Appellants in the Specification (19:21-21:10). Appellants disclose that for the formation indices measured "[s]pecifically, 20 samples for the Formation index testing are cut from a cross direction width strip of the nonwoven at locations throughout the strip" (Specification 20:14-15). Although the Examples are all directed to formation index averages of 20 samples (*see* Tables 2, 3, and 4; Specification 33-34), we determine that there is no express disclaimer that a formation index may not taken for a single sample or be an average of less than (or more than) 20 samples. Therefore, we cannot read the particular embodiment of an average of 20 samples into the claimed formation index when the claim language is broader than this embodiment.

In view of our claim construction discussed above, we determine that the test data for "hot FDU" processes discloses formation index values within the scope of claim 1 on appeal for nonwoven material comprising a web made of substantially continuous A/B bicomponent crimped fibers (*see* Ans. 4 and 7-9). The Examiner finds that the "hot FDU" data on page 34 of the Specification is representative of the disclosure of Pike, and we determine that Appellants have not contested this finding (Ans. 7-9; *see* the

Reply Br. and Supp. Br. in their entirety). We further note that not only Rep 1 for code 14 has top and wire formation index values with a difference of less than 11% as required by claim 1 on appeal, but other samples such as Reps 4 and 17 also meet this limitation, as would an average of these three samples.

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a prima facie case of anticipation in view of the reference evidence, which prima facie case has not been adequately rebutted by Appellants' arguments. Since anticipation is the epitome of obviousness, we determine that the Examiner has also established obviousness under § 103(a). Therefore, we affirm the Examiner's rejection of claim 1, as well as claims 2-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 which stand or fall with claim 1.

C. The Rejection over Pike in view of Suddeth

As discussed above, Appellants do not contest or dispute the Examiner's application of Suddeth for the teaching of adding titanium dioxide to fibers in absorbent products to provide a white coloration, merely repeating arguments against Pike (Ans. 5; App. Br. 9). Therefore, we adopt the Examiner's factual findings and conclusion of law regarding this rejection.

D. Summary

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-3380  
Application 10/749,805

AFFIRMED

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